

REMARKS

The Examiner is thanked for the indication of allowable subject matter of claims 2-4, 8, 14, and 16. Accordingly, the subject matter of claim 2 is placed into claims 1 and 19 and claim 2 is canceled. Similarly, the subject matter of claim 8 has been placed in claim 13, so that claim 13 is allowable. Claims 1, 3-11, and 13-22 are therefore allowable as previously indicated by the Examiner.

This is a Response to the Office Action mailed October 10, 2006, in which a three (3) month Shortened Statutory Period for Response has been set, due to expire January 10, 2007. Twenty-two (22) claims, including four (4) independent claims, were paid for in the application. Claims 1, 13, and 19 are currently amended and claim 2 is canceled. No new matter has been added to the application. No fee for additional claims is due by way of this Amendment. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. Upon entry of the amendments herewith, claims 1 and 3-22 remain pending.

1. Rejections Under 35 U.S.C. § 102(b)

In the Office Action, at page 2, claims 1, 5-6, 12-13, and 17-19 stand rejected under 35 U.S.C. §102(b) as allegedly unpatentable by *Hideya* (JP 10-106008), hereinafter *Hideya*. For a proper rejection of a claim under 35 U.S.C. § 102, the cited reference must disclose all elements and/or features of the claim. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claims 5-6 and 17-18

Because independent claim 1 is allowable over the cited art of record, dependent claims 5-6 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 5-6 contain all features/elements of independent claim 1. Similarly, because independent claim 13 is allowable over the cited art of record, dependent claims 17-18 (which depend from independent claim 13) are allowable as a matter of law for at least the

reason that the dependent claims 17-18 contain all features/elements of independent claim 13. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these claims should be withdrawn.

b. Claim 12

Applicants respectfully submit that independent claim 12 is allowable for at least the reason that *Hideya* does not disclose, teach, or suggest at least the feature of “employing a pulse train pattern having a smaller number of pulses whose level is set to a level corresponding to a recording power as a ratio of a track pitch TP of the optical recording medium to a diameter of a spot of the laser beam becomes smaller and modulating the power of a laser beam thereby to form a recording mark in the predetermined region of the at least one recording layer,” as recited in claim 12 (emphasis added).

Hideya does not disclose, teach, or suggest at least a ratio of track pitch to spot diameter. *Hideya* discloses, at most, a system that “when the size to the basic clock of the pulse width of said record signal whose optical disk unit of this invention is the luminescence section of said light source in (1) has a small linear velocity seen in the location of said optical head, it is narrow, and when large, it is characterized by being controlled to become large” (paragraph 0009). Nowhere is there any reference to track pitch or a ratio of track pitch to spot diameter. Thus, *Hideya* does not anticipate claim 12, and the rejection should be withdrawn.

2. Rejections Under 35 U.S.C. § 103(a)

In the Office Action, at page 4, claims 9-11 and 20-22 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Hideya* in view of *Mizushima et al.* (U.S. Patent Publication 2004/0174796, PCT filed on September 11, 2002), hereinafter *Mizushima*.

The present application was filed in the U.S. on November 19, 2004, and claimed priority to Japanese Patent Application No. 2002-159998 filed on May 31, 2001. The May 31, 2001 foreign priority date precedes the September 11, 2002, filing date of *Mizushima*. Therefore,

Mizushima does not properly qualify as prior art. Accordingly, it is respectfully requested that the rejection made on the basis of *Mizushima* be withdrawn.

Furthermore, because independent claim 1 is allowable over the cited art of record, dependent claims 9-11 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 9-11 contain all features/elements of independent claim 1. Similarly, because independent claim 19 is allowable over the cited art of record, dependent claims 20-22 (which depend from independent claim 19) are allowable as a matter of law for at least the reason that the dependent claims 20-22 contain all features/elements of independent claim 19. Accordingly, the rejection to these claims should be withdrawn.

3. Conclusion

Applicants again thank the Examiner for indicating the allowable subject matter of claims 2-4, 8, and 14-17. In light of the above amendments and remarks, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that all pending claims 1 and 3-22 are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and timely allow all pending claims. The Examiner is encouraged to contact Mr. Armentrout by telephone to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is further encouraged to contact Mr. Armentrout by telephone to expediently correct such informalities.

Respectfully submitted,

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